



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,450	11/10/1999	JONATHAN H. FREEDMAN	1579-315	7992

7590 12/04/2001
NIXON & VANDERHYE PC
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201

EXAMINER

PARAS JR, PETER

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 12/04/2001

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/437,450

Applicant(s)

FREEDMAN ET AL.

Examiner

Peter Paras

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 5-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

The reply filed on July 5, 2001 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the figure 5 legend on page 7 does not clearly indicate which sequences correspond to which SEQ ID NOs. For example, it is not clear if DDRT1 corresponds to SEQ ID NO 11 or if DDRT9 corresponds to SEQ ID NO 11 assuming that MLC corresponds to SEQ ID NO 10 as would be consistent with the interpretation of the table legend. Also, it appears that the sequences in table III are intended to correspond to the sequences in figure 5, however it is not clear which of the sequences in table III and which SEQ ID NOs correspond to which sequences listed in figure 5. Additionally, the first sequence listed in figure 5 is named DDRT21 however, table III does not list a sequence named DDRT21. All the sequences listed in figure 5 must correspond to the sequences listed in table III by the appropriate SEQ ID NO. Finally, the SEQ ID NOs recited in the claims do not correspond with the sequence names as listed in table III or figure 5. For example in claim 5, DDRT2 has been given the sequence of SEQ ID NO: 34, however one would not understand from figure 5 that DDRT2 corresponds to SEQ ID NO: 34. Appropriate amendments to the figures, specification, and claims are required so that it is clear which sequences correspond to which SEQ ID NOs. Applicants are cautioned against the inclusion of new matter when making the necessary amendments. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply

the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 5, 9, and 13, drawn to the nucleic acid sequence set forth in SEQ ID NO: 34 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclasses 23.1 and 13.
- II. Claims 6, 10, and 14, drawn to the nucleic acid sequence set forth in SEQ ID NO: 50 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- III. Claims 7, 11, and 15, drawn to the nucleic acid sequence set forth in SEQ ID NO: 40 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- IV. Claims 8, 12, and 16, drawn to the nucleic acid sequence set forth in SEQ ID NO: 14 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- V. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 37 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.

- VI. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 11 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- VII. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 4 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- VIII. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 52 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- IX. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 51 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- X. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 49 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XI. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 43 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XII. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 38 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.

- XIII. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 36 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XIV. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 35 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XV. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 33 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XVI. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 44 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XVII. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 31 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XVIII. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 15 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XIX. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 13 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.

- XX. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 8 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XXI. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 3 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XXII. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 28 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XXIII. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 26 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XXIV. Claims 17-19, drawn to the nucleic acid sequence set forth in SEQ ID NO: 25 and a transgenic *C. elegans* comprising the same nucleic acid sequence, classified in classes 536 and 800, subclass 23.1 and 13.
- XXV. Claim 19, drawn to a transgenic *C. elegans* comprising the nucleic acid sequence set forth in SEQ ID NO: 20, classified in class 800, subclass 13.
- XXVI. Claim 19, drawn to a transgenic *C. elegans* comprising the nucleic acid sequence set forth in SEQ ID NO: 19, classified in class 800, subclass 13.
- XXVII. Claim 19, drawn to a transgenic *C. elegans* comprising the nucleic acid sequence set forth in SEQ ID NO: 9, classified in class 800, subclass 13.

XXVIII. Claim 19, drawn to a transgenic *C. elegans* comprising the nucleic acid sequence set forth in SEQ ID NO: 18, classified in class 800, subclass 13.

XXIX. Claim 19, drawn to a transgenic *C. elegans* comprising the nucleic acid sequence set forth in SEQ ID NO: 17, classified in class 800, subclass 13.

Inventions I-XXIX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the products of Groups I-XXIX have different modes of operation, different functions, and different effects. The products of Groups I-XXIX have different chemical structures each from the other and may be used in materially different methods. For example, the nucleic acid sequences of Groups I-XXIV have different chemical structures and would encode different polypeptides that have different functions while the transgenic *C. elegans* of Groups XXV-XXIX have different chemical structures each from the other and different phenotypes resulting from expression of different transgenes and may be used as models of different diseases. The claimed nucleic acid sequences and transgenic *C. elegans* may be used in different assays, which require materially different products and technical considerations. For example, the nucleic acid sequences of Groups I-XXIV may be used as probes in hybridization assays while the transgenic *C. elegans* of Groups XXV-XXIX may be used as models of disease. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject

matter that require a separate search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Peter Paras, Jr., whose telephone number is 703-308-8340. The examiner can normally be reached Monday-Friday from 8:30 to 4:30 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda, can be reached at 703-305-6608. Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Inquiries of a general nature or relating to the status of the application should be directed to Kay Pinkney whose telephone number is (703) 305-3553.

Peter Paras, Jr.
Art Unit 1632


DEBORAH J. R. CLARK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600